

REMARKS

An Office Action was mailed on August 29, 2003. Claims 1-40 are pending.

OBJECTION TO THE SPECIFICATION

The Examiner objected to the Abstract because it is not clear and concise. Responsive thereto, Applicant has replaced the Abstract with the following: -- A method of controlling the shape, motion and the like of a second object symbolizing the shadow of a first object in a virtual space, whereby the second and first objects are personalized virtual characters in a 3D virtual space of a video game and whereby the second object is controllable independently of the first object. -- Applicant respectfully submits that such Abstract is clear and concise and descriptive of the present invention.

The Examiner also objected to the incorporation by reference of a foreign application or patent. Responsive thereto, Applicant has deleted the first paragraph of the specification because such first paragraph relates to the foreign priority claims under 35 U.S.C. §119(a-d), and not to a domestic benefit claim under 35 U.S.C. §120 or §119(e).

Accordingly, it is respectfully requested that the Examiner withdraw the objections to the specification.

OBJECTIONS TO THE DRAWINGS

The Examiner also objected to the drawings because the language of the claims is not consistent with the language of the drawings. Responsive thereto, Applicant has amended the claims to be consistent with the drawings. In particular, the claims now provide for a first character, a shadow character and acquired items, instead of a multiplicity of "objects." Such "characters" and "items" are clearly represented throughout the drawings and specification. Accordingly, it is respectfully requested that the Examiner withdraw the objection to the drawings.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-40 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Responsive thereto, Applicant has amended all the claims to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As

noted above, such claims use "character" and "acquired item" terminology instead of "object" terminology. Furthermore, Applicant respectfully submits that one skilled in the art would clearly grasp the subject matter of the invention with reference to the amended claims and originally-filed specification and drawings.

Regarding claims 1, 14, 27 and 40, Applicant has addressed the Examiner's concerns by providing for a generated first character and generating the shadow character as a shadow projection of the first character relative to a virtual light source. This definition is clearly supported in the specification and drawings.

Regarding claims 3, 16 and 29, Applicant has addressed the Examiner's concerns by using "character" and "acquired item" terminology instead of "object" terminology. Thus, the first character has a first acquired item while the shadow character has a shadow acquired item (see FIG. 13). Such amendments also address the Examiner's concerns regarding claims 4, 17 and 30.

Regarding claims 5, 18 and 31, Applicant respectfully submits that the shape of the "predetermined shape" *per se* does not have to be defined in the claims as such shape is merely denoted as being "predetermined" or determined at a point in time prior to the present (see pages 38 and 39 of the specification).

Regarding claims 7, 20 and 33, Applicant respectfully submits that such claims are no longer contradictory. See also the last paragraph on page 28 and the first paragraph on page 29 of the specification concerning the concept of circumferential environment condition, which is related to the generation of the shadow character depending on at least the position of the virtual light source.

Regarding claims 10, 23 and 35, Applicant respectfully submits that the claim amendments that overcome the antecedent basis issues also overcome the functionality questions.

Regarding claims 12, 25 and 38, and aside from the clarifying amendments to such claims, the Examiner is respectfully directed to the first paragraph of the Summary of the Invention, as well as the paragraph bridging pages 21 and 22 of the specification.

Accordingly, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

REJECTIONS UNDER 35 U.S.C. §101

Claim 40 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Responsive thereto, Applicant has amended claim 40 to provide that the program is tangibly stored. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. §101 be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Horigami et al. (U.S. Patent 6,585,599). The Examiner asserts that ally character 112 is a shadow of hero character 111 and that they are controlled independently of each other. However, it is clear that the Examiner is reading the Horigami et al. reference way too broadly. Under the Examiner's broad interpretation, any ally character in any computer game would be considered a "shadow," when the intent of Horigami et al. is clearly not to describe a "shadow" as intended by the Applicant.

To clearly overcome the Horigami et al. reference, Applicant has amended the claims to provide that the shadow character is generated from the first character in virtual space with respect to a virtual light source and to the first character such that said shadow character symbolizes a shadow projection of said first character. Support for such an amendment is clearly found in the originally-filed specification and drawings (see FIG. 5 for example). Applicant's definition of the "shadow character" thus goes beyond the definition of the Horigami et al. teaching of the ally characters set forth at column 10, lines 23-40:

On the ROM 6, the program for executing the role playing game is stored. FIG. 2 shows the configuration of a game screen displayed on the monitor 11 at the time of a battle in the role playing game. In a game screen 100, there is represented such a state that a character 111 of a hero of the game and two characters 112 and 113 taking the hero's side are surrounded by three-enemy characters 121, 122 and 123. The character 111 is set as the operation object of the player. As for the ally characters 112 and 113 as well, they may be operated by the player conducting predetermined switching operation on the controller 14. The hero character 111 and his ally characters 112 and 113 form an ally party 110. An assembly of enemy characters 121 to 123 forms an enemy party 120. The number of characters for the ally party 110 and the enemy party 120 is not restricted to three, but the number can be changed according to the progress of the game

There is no discussion of the ally characters 112 and 113 being generated as light-induced, shadow projections of the hero character 111.

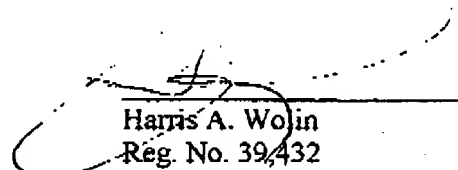
Furthermore, the passage referenced by the Examiner, i.e., Column 5, Lines 1-10 of Horigami et al., merely notes that the "respective characters" of the "at least one character" take action in accordance with a predetermined program. There is no discussion in such passage of the ally character being formed as a shadow projection of the hero character. The Examiner cannot simply impute the term "shadow" onto the ally character for convenience. Thus, Applicant respectfully submits that the claimed invention is clearly patentable over Horigami et al. and that the rejection under 35 U.S.C. §103(a) should be withdrawn.

For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections and rejections. In view of the above amendments and remarks, it is believed that claims 1-40, consisting of independent claims 1, 14, 27 and 40 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,


Harris A. Wolin
Reg. No. 39,432

CUSTOMER NUMBER 026304
PHONE: (212) 940-8708
FAX: (212) 894-5708 (direct)
DOCKET NO.: SCEY 19.027 (100809-16276)